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REMARKS

In response to the non-final Office Action of June 3, 2005, Applicant asks that all claims be allowed in view of the amendments to the claims and the following remarks.

Claims 1-82 are now pending, of which claims 1, 44, 55, 66 and 73 are independent. Claims 1, 25, 36, 39, 42-44, 53-55 and 64-66 have been amended, and claims 67-82 have been added. Support for these new claims may be found in the application at, for example, page 24, line 19 to page 25, line 30. Applicant asserts that no new matter has been introduced.

Claims 36-43, 53, 54, 64, and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicant thanks Examiner for this indication of allowable subject matter.

The specification has been amended to correct a typographical error at page 25, line 12 and to be consistent. In particular, the label for reference number 547 of FIG. 5 at page 25, line 23 has been amended to be consistent with references made elsewhere in the specification as "end date field 547." Compare, e.g., specification at page 25, lines 10, 11, 15, 16, 18, 21 and 22 with page 25, line 23. No new matter has been introduced.

Rejection under Section 101

Claims 1-66 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has amended independent claims 1, 44, 55, and 66 to address the Examiner's concerns.

As amended, claim 1 recites a method that is performed at least partially by a computer. Furthermore, the method recited in claim 1 involves accessing information stored in a computer storage medium.

Moreover, 35 U.S.C. § 101 defines the subject matter that is patent-eligible as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." See MPEP § 706.03(a). A process is further defined as a "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." See MPEP § 706.03(a). Because claims 1 sets forth a method of providing

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notification information corresponding to a communication identity, the claims are to a process and therefore satisfy the requirements of 35 U.S.C. § 101.

As such, claim 1. is directed to statutory subject matter. For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and its dependent claims 2-43.

Claim 44 stands rejected because "the claim clearly indicates 'signal.'" See Office Action, page 3. Claim 44 has been amended to eliminate such an indication. Consequently, claim 44 recites a computer-readable medium having embodied thereon a computer program configured to, when executed, provide notification information corresponding to a communication identity.

As such, claim 44 is directed to statutory subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 44 and its dependent claims 45-54.

Claims 55 and 66 stand rejected because the recited systems are "not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement." See Office Action, page 3. As amended, claims 55 and 66 recite "a computer storage medium," which is an example of hardware, outside of an intended use statement.

Moreover, as noted above, 35 U.S.C. § 101 defines the subject matter that is patent-eligible as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." See MPEP § 706.03(a). Because each of claims 55 and 66 set forth computer-based systems of providing notification information corresponding to a communication identity, the claims are to a machine and therefore satisfy the requirements of 35 U.S.C. § 101.

As such, claims 55 and 65 are directed to statutory subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 55 and 66, and dependent claims 56-65.

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Rejection Under Section 103

Claims 1-6, 8-10, 16-22, 25-27, 29-34, 44-48, 50-52, 55-59, 61-63, and 66 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (U.S. Patent No. 6,714,791) in view of Hendrey et al. (U.S. Patent Application No 2003/0060214). Applicant traverses the rejection.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 44, 55, and 66 because Friedman and Hendrey, either alone or in combination, fail to describe or suggest all of the features of independent claims 1, 44, 55, and 66. For example, Friedman and Hendrey fail to describe or suggest "a temporal condition including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period," as recited in claims 1, 44, 55, and 66.

Independent claim 1 recites a method that is performed at least partially on a computer and provides notification information corresponding to a communication identity. The method includes accessing notification setting information stored in a storage medium that identifies a temporal condition. The temporal condition includes at least one temporal period during which notification information is to be provided or withheld. A beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period. The method also includes determining whether the temporal condition is satisfied, and controlling dissemination of notification information related to the communications identity based on whether the temporal condition is satisfied. Independent claim 44 recites similar features in the context of a computer-readable medium, as do independent claims 55 and 66 in the context of a system.

Friedman describes providing information identifying locations of users of an instant messaging system. See Friedman, col. 12, line 60 to col. 13, line 1. Each of the users maintains a contact list including identifiers of other users with whom the user regularly communicates, and the user may associate conditions with one or more users or groups of users included in the contact list. The condition may determine whether the corresponding users or groups of users are to be provided with information identifying the location of the user. See Friedman, col. 13, lines 1-3. Furthermore, the condition may determine a granularity or precision with which the location information is provided to the corresponding users. For example, location information

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may be provided by city, zip code, area code, or latitude and longitude. See Friedman, col. 13, lines 17-21.

The Office Action acknowledges that "Friedman does not teach a temporal condition including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period." See Office Action, page 5. For this feature, the Office Action relies on Hendrey.

Specifically, the Office Action references paragraph 0050 of Hendrey to teach "a temporal condition including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period," as recited in claim 1, 44, 55, and 66. The referenced paragraph reads, in pertinent part, "a user can specify a rule that when the user is home, the user is invisible to ListNearbyUsers 306 requests made by other users." As such, the referenced section of Hendrey describes making a user invisible to other users based on whether the user is located at the user's house – that is, based on a location of the user. More particularly, the cited section of Hendry describes enabling other users to determine the location of the user relative to the other users based on the location of that user. In contrast, claims 1, 44, 55, and 66 recite controlling dissemination of notification information related to a communications identity based on whether the temporal condition is satisfied, where the temporal condition includes a temporal period during which notification information is to be provided or withheld.

Furthermore, as Hendrey does not describe or suggest a temporal condition including at least one temporal period during which notification information is to be provided or withheld, Hendrey also does not describe or suggest the temporal period being specified in the notification setting information in advance of the beginning of the temporal period, as recited in claims 1, 44, 55, and 66.

Moreover, Hendrey, in the referenced section or anywhere else, does not describe or suggest a temporal condition including a temporal period during which notification information is to be provided or withheld. As such, Hendrey does not describe or suggest accessing notification setting information stored in a storage medium that identifies a temporal condition

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including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period, as recited in claims 1, 44, 55 and 66. Consequently, Friedman, Hendrey, or any proper combination of the references, does not describe or suggest "a temporal condition including at least one temporal period during which notification information is to be provided or withheld, wherein a beginning and an end of the at least one temporal period are specified in the notification setting information in advance of the beginning of the temporal period," as recited in claims 1, 44, 55, and 66. Applicant therefore submits that the Office action has not properly made a prima facie case of obviousness. For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 44, 55, and 66 and their respective dependent claims 2-43, 45-54 and 56-65.

Claim 7, which depends from independent claim 1, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Hendrey and further in view of Barclay (U.S. Patent Application No. 2003/0119522). As discussed above with respect to independent claims 1, 44, 55, and 66, Friedman and Hendrey, either alone or in combination, fail to describe or teach the features in the independent claims. Barclay describes providing location information to parties participating in a telephone call on a subscription or ad hoc basis. See Barclay, Abstract. Barclay, however, does not cure the failure of Friedman, Hendrey or any proper combination of the references to describe or suggest the subject matter of the independent claims. Nor does the Office Action contend Barclay does so. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 7.

Claims 11-15, 49, and 60, which depend from independent claims 1, 44, and 55, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Hendrey and further in view of Gudjonsson et al. (U.S. Patent No. 6,564,261). Gudjonsson describes, "A network [that] provides users with a simple and secure way of establishing communication sessions with other users or services, running either over IP networks or other networks, e.g., PSTN. See Gudjonsson, Abstract. Gudjonsson, however, does not remedy the failure of Friedman, Hendrey or any proper combination of the references to describe or suggest the

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subject matter of the independent claims. Nor does the Office Action contend Gudjonsson does so. For at least this reason, and based on their dependency from independent claims 1, 44, and 55, Applicant respectfully requests withdrawal of the rejection of claims 11-15, 49, and 60.

Claims 23 and 24, which depend from independent claim 1, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Hendrey and further in view of Karstens (U.S. Patent Application No. 2005/0071435). Karstens describes the expiration of users, for example, from an instant messaging contact list based on a lack of instant messaging activity. See Karstens, Abstract. Karstens, however, does not remedy the failure of Friedman, Hendrey or any proper combination of the references to describe or suggest the subject matter of the independent claim. Nor does the Office Action contend Karstens does so. For at least this reason, and based on their dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claims 23 and 24.

Claim 28, which depends from independent claim 1, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Hendrey and further in view of Rahman et al. (U.S. Patent No. 6,463,292). Rahman describes redirecting alert messages received at a mobile station based on user input. See Rahman, Abstract. As such, Rahman fails to remedy the deficiency of Friedman, Hendrey or any proper combination of the references to describe or suggest the subject matter of the independent claims. Nor does the Office Action contend Rahman does so. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 28.

Claim 35, which depends from independent claim 1, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Friedman in view of Hendrey and further in view of deCarmo (U.S. Patent Application No. 2004/0010808). deCarmo describes, "a system that manages a user's presence and allows the user to participate in instant messaging without unnecessarily distracting the user from the interactive video/multimedia experience." See deCarmo, paragraph 0005. deCarmo, however, fails to remedy the failure of Friedman, Hendrey or any proper combination of the references to describe or suggest the subject matter of the independent claims. Nor does the Office Action contend deCarmo does so. For at least this reason, and based on its dependency from independent claim 1, Applicant respectfully requests withdrawal of the rejection of claim 35.

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New Claims 67-82

Each of claims 67-72 directly or indirectly depend from independent claim 1, 44 or 55. At least for the reason of that dependency and the reasons noted above with respect to independent claims 1, 44 or 55, applicant submits that claims 67-72 are allowable.

Newly added independent claim 73 recites a method, performed at least partially on a computer, for providing notification information corresponding to a communication identity. The method includes accessing notification setting information stored in a computer storage medium that identifies a temporal condition. The temporal condition includes at least one temporal period during which notification information is to be provided or withheld. The notification setting information defines a duration and specifies at least one of a beginning and an end of the duration. The method also includes determining whether the temporal condition is satisfied, and controlling dissemination of notification information related to the communications identity based on whether the temporal condition is satisfied.

For at least the reasons noted above with respect to claim 1, applicant submits claim 73 and its dependent claims 74-82 are allowable.

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment, including the Office Action's characterizations of the art, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Applicant reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

Applicant submits that all claims are in condition for allowance.

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Pursuant to 37 CFR §1.136, applicant hereby petitions that the period for response to the action dated June 3, 2005, be extended for one month to and including October 3, 2005.

Enclosed is a check in the amount of $1120.00 for the excess claim fee ($1000.00) and the Petition for Extension of Time fee ($120.00). Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: October 3, 2005

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